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TRANSFERWISE LTD v. PUBLIC BANK BHD

COURT OF APPEAL, PUTRAJAYA
AZIZAH NAWAWI JCA
SEE MEE CHUN JCA
MOHAMED ZAINI MAZLAN JCA
B [CIVIL APPEAL NO: W-02(IPvC)(A)-1095-06-2022]
5 NOVEMBER 2024

Abstract – *To be considered as an 'aggrieved person' under s. 46(1)(a) of the Trademarks Act 2019, a party must: (i) have used their own mark as a trademark or have a genuine and immediate intention to do so; (ii) operate in a trade that is identical or similar to the trade of the registered trademark owner; (iii) have a legal interest, right, or legitimate expectation in their own mark; and (iv) demonstrate that their interests are substantially impacted by the presence of the registered mark. The aggrieved person, being the party seeking to expunge a trademark based on non-use, bears the initial burden of presenting prima facie evidence of non-use. The registered trademark owner then has the burden of rebutting this evidence and demonstrating genuine use of the trademark for the registered services.*

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INTELLECTUAL PROPERTY: *Trade mark – Expungement and removal – Application for – Whether party seeking for expungement aggrieved person – Whether there had been non-use by registered trademark owner of trademark for continuous period of three years following issuance of notification of registration – Trademarks Act 2019, s. 46(4)*

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The respondent was one of the largest banking groups in Malaysia and was the registered proprietor of the trademark no. 97021886 in Class 36 ('respondent's trademark'), registered on 23 December 1997. The respondent's trademark was a combination of: (i) a graphic depicting a piggy bank in the form of a child wearing a cap, emblazoned with the word 'wise' and a coin; and (ii) the words 'Akaun Simpanan' 'Savings Account' 'WISE – wisdom in saving early'. The respondent had been providing savings account specifically targeted for children. The appellant was a private limited company incorporated in England and Wales on 31 March 2010, under the name Exchange Solutions Ltd. Following the appellant's rebranding in February 2021 and its name change to Wise Payments Ltd in June 2021, the appellant, along with its affiliates and subsidiaries, began providing currency exchange and transfer services in the United Kingdom and in various other jurisdictions under and by reference to the following marks: (i) Wise word mark; and (ii) Wise combination mark. In Malaysia, the appellant began offering currency exchange and transfer services (excluding e-money accounts and multi-currency debit cards) in 2017 through a third party, Tangio Sdn Bhd ('Tangio') using the TransferWise word mark. In November

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2019, the appellant began providing these services through its wholly-owned subsidiary, Wise Payments Malaysia Sdn Bhd ('Wise Payment Malaysia'), under the same mark. Following the global rebranding in February 2021, the appellant, *via* Wise Payments Malaysia, had been providing the services using the Wise word mark and Wise combination mark ('Wise marks'). In December 2021, the appellant launched and commenced the service of providing e-money accounts and multi-currency debit cards in Malaysia using the Wise marks. The appellant contended that it had genuine and present intention to expand its currency exchange and transfer services in Malaysia in the near future. The appellant had filed for the registration of its TransferWise word mark and TransferWise combination mark and Wise word mark and Wise combination mark in Malaysia. The appellant filed an application, at the High Court, pursuant to s. 46(1), read together with s. 46(4) of the Trademarks Act 2019 ('Act'), seeking the following prayers: (i) trademark registration no. 97021886 in Class 36 for the respondent's registered Wise trademark, in the name of Public Bank Berhad, be expunged and removed from the Register of Trademarks Malaysia ('Register'), save and except in relation to 'Children's Savings Account' ('prayer 1'); (ii) alternatively, the specification of services for which the said trademark is registered pursuant to the trademark registration no. 97021886 in Class 36 be limited to 'banking accounts' ('prayer 2'); and (iii) in the event that prayer 1 or 2 is granted, a sealed copy of the court's order is served on the Registrar of Trademarks ('Register') so that the Registrar would rectify and correct the Register accordingly. The High Court Judge ('HCJ') dismissed the appellant's application. Hence, the present appeal.

Held (allowing appeal):
Per Azizah Nawawi JCA delivering the judgment of the court:

(1) For the purpose of s. 46(1)(a) of the Act, the appellant would have to establish two conditions, namely: (i) the appellant was an aggrieved person; and (ii) there had been non-use by the respondent of his registered trademark for a continuous period of three years following the issuance of the notification of registration. (para 27)

(2) Based on case laws, an aggrieved person is one who has either used their mark as a trademark or has a genuine and immediate intention to do so in a trade that is identical or similar to the trade of the owner of the registered trademark that they seek to remove from the Register. This person must also have a legal interest, right or legitimate expectation in their own mark and that his interest/rights is substantially impacted by the presence of the registered mark. The appellant was an aggrieved person within the meaning of s. 46 of the Act and, therefore, had the necessary *locus standi* to make the application pursuant to s. 46(1)(a) and (4) of the Act. The appellant's Wise marks (and previously its TransferWise marks) had been used in Malaysia and were currently used in Malaysia in respect of currency exchange and transfer services by its subsidiary, Wise Payments Malaysia, since February 2021. Wise

A Payments Malaysia was duly licensed to carry its business by Bank Negara Malaysia under the Money Services Business Act 2011. Furthermore, the appellant had a genuine and present intention to use the Wise marks for its expanded services in Malaysia. The appellant was not a mere busybody and clearly had a trading interest *vis-à-vis* the Wise B marks. The appellant, having used the Wise marks in various jurisdictions, and having expanded its services to Malaysia, had a legal interest to use its Wise marks in Malaysia. Given that both the Wise marks and the PBB registered Wise marks comprised the word 'Wise', the presence of the PBB registration on the Register may substantially C affect the appellant. (paras 33-35, 42, 45 & 46)

(3) At the High Court, the appellant had presented two investigation reports to show *prima facie* non-use of the mark. The appellant had also confirmed, through checks on the respondent's website (including archived versions since 2004), internet searches dating back to 1997 and D inquiries with the respondent's staff, that the PBB registered Wise Mark was only used for children's savings accounts and not for any other services. The evidence presented by the appellant was strong enough to show, on a *prima facie* basis, that the respondent had not used the PBB registered Wise mark for any services, other than children's savings E accounts during the relevant statutory period. The respondent, on the other hand, failed to rebut the evidence and to establish use of the PBB registered Wise mark in respect of any of the registered services. The evidence presented by the respondent only showed use of the PBB registered Wise mark in respect of 'children's savings accounts'. There was no evidence of its use for any other services, which aligned with the F findings in the investigation reports provided by the appellant. (paras 55, 59, 60, 62 & 66)

(4) The HCJ erred in fact and in law when His Lordship held that the services related to banking and finance could not be easily severed and G compartmentalised, that the services for which the PBB registered Wise marks was registered were directly relevant to the services provided by the respondent and for future services. Since it had been clearly established that the PBB registered Wise mark was only used for 'children's savings accounts', the HCJ should have partially revoked the PBB registration, limiting it to 'banking' and 'financial' services only, H as 'children savings account' fell within these two services. (paras 77 & 78)

Case(s) referred to:

Agricultural And Processed Food Products Export Development Authority Of India (APEDA) & Ors v. Syarikat Faiza Sdn Bhd [2011] 9 CLJ 394 HC ***(refd)***

I *Appraisal Property Management Sdn Bhd & Ors v. Singham Sulaiman Sdn Bhd [2023] 2 CLJ 206 CA* ***(refd)***

Colliers International Property Consultants Inc v. Colliers International Property Consultants Sdn Bhd [2015] 1 LNS 252 HC ***(refd)***

Essity Hygiene And Health AB v. Praba's Vcare Health Clinic Privited Limited [2019] 1 LNS 1124 HC ***(refd)***
e-Toyo Global Stationery Sdn Bhd v. Toyo Ink Sdn Bhd & Anor [2004] 7 CLJ 368 HC ***(refd)***
Godrej Sara Lee Ltd v. Siah Teong Teck & Anor (No 2) [2007] CLJU 230; [2007] 1 LNS 230 HC ***(refd)***
Lam Soon Edible Sdn Bhd v. Hup Seng Perusahaan Makanan (M) Sdn Bhd [2010] 5 CLJ 975 HC ***(refd)***
LB (Lian Bee) Confectionery Sdn Bhd v. QAF Ltd [2012] 3 CLJ 661 FC ***(refd)***
Liwayway Marketing Corporation v. Oishi Group Public Co Ltd [2017] 5 CLJ 133 FC ***(refd)***
McLaren International Ltd v. Lim Yat Meen [2009] 4 CLJ 749 FC ***(refd)***
Mercury Communications Limited v. Mercury Interactive (UK) Limited [1995] FSR 22 ***(refd)***
Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party) [2015] 9 CLJ 125 FC ***(refd)***
Minerva Trade Mark [2000] FSR 27 ***(refd)***
Weir Warman Ltd v. Research & Development Pty Ltd [2007] SGHC 59 ***(refd)***

Legislation referred to:
Trade Marks Act 1976, ss. 45, 46
Trademarks Act 2019, ss. 36(2), (3), 46(1)(a), (4), 47

Trade Marks Act 1988 [Sing], s. 22(6)
Trade Marks Act 1994 [UK], s. 46(5)

Other source(s) referred to:
Kerly's Law of Trade Marks and Trade Names, 12th edn, p 206

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For the respondent - Michael Soo, Yu Shi Yang & Annabelle Koh Jing Yi; M/s Shook Lin & Bok

[Editor's note: Appeal from High Court, Kuala Lumpur; Originating Summons No: WA-24IP-7-04-2021 (overruled).]

Reported by Najib Tamby

JUDGMENT

Azizah Nawawi JCA:

Introduction

[1] This is an appeal against the decision of the learned High Court Judge who dismissed the appellant's application pursuant to sub-s. 46(1)(a) and 46(4) of the Trademarks Act 2019 ("TMA 2019") to partially revoke the respondent's Trademark Registration No 97021886 (PBB Registration) for the trademark save and except for 'children's savings accounts' accounts'.

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The Salient Facts

[2] The respondent is one of the largest banking groups in Malaysia and is the registered proprietor of the trademark no. 97021886 in Class 36 ("respondent's trademark") registered on 23 December 1997 as follows:

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TRADEMARK REG. NO.	TRADEMARK	REG. DATE	DATE OF ISSUANCE OF NOTICE OF REG.	SPECIFICATION OF SERVICES
97021886		23.12.1997	9.1.2002	banking, financial, insurance and investment services; real estate; securities brokerage; stock brokerage; computerised financial services; issuing letters of credit and travellers cheques; financing of loans; safe deposit and surety services; issuing statements of accounts; mortgage and purchase financing; money exchange services; automatic cash dispensing services; electronic funds transfer and automated payment services; credit and cash card services; trustee services, commodities and futures brokerage, management services for loan related transactions and financial planning services; all included in class 36.

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[3] The respondent's trademark is depicted as follows:

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[4] The respondent's trademark is a combination of:

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(i) a graphic depicting a piggy bank in the form of a child wearing a cap emblazoned with the word "wise" and a coin; and

(ii) words "akaun simpanan" "savings account" "WISE – wisdom in saving early".

[5] The defendant's trademark was registered under Class 36 for the following specified services: "banking, financial, insurance and investment services; real estate; securities brokerage; stock brokerage; computerised financial services; issuing letters of credit and travellers cheques; financing of loans; safe deposit and surety services; issuing statements of accounts; mortgage and purchase financing; money exchange services; automatic cash dispensing services; electronic funds transfer and automated payment services; credit and cash card services; trustee services, commodities and futures brokerage, management services for loan related transactions and financial planning services."

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[6] The respondent has been providing savings accounts specifically targeted for children using the respondent's trademark in Malaysia since 1997.

[7] The appellant is a private limited company incorporated in England and Wales on 31 March 2010 under the name Exchange Solutions Ltd. On 3 August 2012 the appellant carried out its first name-change to TransferWise Ltd. On 25 June 2021, the appellant's name was changed for the second time to its current name, Wise Payments Ltd.

[8] The appellant initially offered foreign currency transfers, electronic money transfers, and currency exchange services in the UK. From 2012 to 2019, they expanded to include e-money accounts and multi-currency debit cards. Currently, the appellant's services comprise foreign currency transfers, electronic money transfers, currency exchange, e-money accounts, and multi-currency debit cards ("currency exchange and transfer services").

[9] The appellant's currency exchange and transfer services are provided in the United Kingdom and various other jurisdictions, initially through its website www.transferwise.com and later, after rebranding to Wise Payments Ltd, through www.wise.com. These services are also accessible *via* the appellant's mobile application.

[10] From 2011 to January 2021, the currency exchange and transfer services were provided by the appellant either directly or through its affiliates, subsidiaries, licensees and/or associated companies in the United Kingdom and in various other jurisdictions employing the following marks:

(i) "TransferWise" ("TransferWise word mark"); and

(ii) TransferWise ("TransferWise combination mark").

[11] Following the appellant's rebranding in February 2021 and its name change to Wise Payments Ltd in June 2021, the appellant, along with its affiliates and subsidiaries, began providing currency exchange and transfer services in the United Kingdom and in various other jurisdictions under and by reference to the following marks:

(i) Wise ("Wise word mark"); and

(ii) wise "Wise combination mark").

[12] In Malaysia, the appellant began offering currency exchange and transfer services (excluding e-money accounts and multi-currency debit cards) in 2017 through a third party, Tangio Sdn Bhd ("Tangio"), using the TransferWise Word Mark.

[13] In November 2019, the appellant began providing these services through its wholly-owned subsidiary, Wise Payments Malaysia Sdn Bhd ("Wise Payment Malaysia"), under the same mark. Following the global

rebranding in February 2021, the appellant, *via* Wise Payments Malaysia, has been providing the services using the Wise word mark and Wise combination mark ("Wise marks").

[14] On 8 December 2021, the appellant launched and commenced providing e-money accounts and multi-currency debit cards in Malaysia using the Wise marks.

[15] The appellant contended that it has a genuine and present intention to expand its currency exchange and transfer services in Malaysia in the near future.

[16] The appellant had filed for the registration of its TransferWise word mark and TransferWise combination mark, and Wise word mark and Wise combination mark in Malaysia as shown in the table below:

No.	Trademarks	Class	Application No.	Application Date
1.	TransferWise | Borderless	36	2018056305	26/3/2018
2.	TRANSFERWISE	9	TM2020012158	24/6/2020
3.	TRANSFERWISE	36	TM2020012160	24/6/2020
4.	Wise	9, 36	TM2020014609	19/6/2020
5.	wise	9, 36	1590102	22/2/2021

[17] The appellant filed an application in the High Court pursuant to sub-s. 46(1)(a) read together with sub-s. 46(4) of the TMA 2019, seeking the following prayers:

(i) Trademark Registration No. 97021886 in Class 36 for the trademark

[PBB Registered Wise Trademark] registered in the name of Public Bank Berhad be expunged and removed from the Register of Trademarks Malaysia, save and except in relation to 'children's' savings account';

(ii) alternatively, the specification of services for which the trademark

is registered pursuant to Trademark Registration No. 97021886 in Class 36 be limited to 'banking accounts'; and

(iii) in the event that prayer 1 or alternatively prayer 2 is granted, a sealed copy of this court's order is served on the Registrar of Trademarks so that the Registrar will rectify and correct the Register accordingly.

Decision Of The High Court Judge

Aggrieved Party

[18] The learned judge made a finding that the appellant is not an aggrieved person as the services using the Wise marks are provided in Malaysia by its Malaysian Subsidiary (Wise Payments Malaysia) and not the appellant, and that the appellant cannot use the Wise marks as it has not been issued with the necessary license by Bank Negara Malaysia.

[19] The court also held that online money transfer services in Malaysia, regulated by Bank Negara Malaysia under the Money Services Business Act 2011, are provided by Wise Payments Malaysia using the Wise marks. The said services were not provided by the appellant. Therefore, in para. (37), the learned judge concluded as follows:

> [37] Based solely on this undisputed fact, and applying the principle distilled from the cases cited earlier, I rule that the plaintiff failed to satisfy the criteria of an aggrieved person, as established in the authorities cited earlier including McLaren and Mesuma Sports. The Plaintiff is not an aggrieved person within the meaning of s. 46 of the TMA 2019. It does not have any *locus standi* to institute this action against the defendant.

Non-use

[20] With regard to non-use, the learned judge made a finding that the appellant had failed to discharge its burden to prove non-use as the respondent had adduced evidence of use of the registered marks.

[21] The learned judge held that the appellant has failed to provide enough evidence to prove that the respondent had not used its trademark. Applying the Federal Court's decision in *Liwayway Marketing Corporation v. Oishi Group Public Co Ltd* [2017] 5 CLJ 133, the learned judge held that the appellant could have proven non-use by conducting a survey, following the guidelines set out in the Whitford Guidelines. Without such a survey, the burden of proving non-use remains with the appellant. The court held that the appellant had failed to meet this burden, especially since the respondent has provided evidence, such as advertisements, posters, and brochures, showing use of the trademark.

[22] The learned judge also found that the respondent's trademark is in actual fact being actively used by the respondent and it is used for the very intent and purpose of that trademark – the Public Bank's children savings accounts.

[23] Even though the court agrees that sub-s. 46(4) of the TMA 2019 allows for partial revocation, the learned judge rejected the appellant's argument that banking and financial services can be easily separated as proposed. While the

respondent's trademark currently focuses on children's banking services, including savings accounts, the learned judge held that the intent of sub-s. 46(4) must be considered in the context of the highly-regulated banking sector. The court also made a finding that the services listed under the respondent's trademark are relevant to both its current and future services.

[24] Further, the learned judge also took note that even if it grants the appellant's request and registers the "Wise word mark" and "Wise combination mark" under Class 36 in the appellant's name, the appellant would not be able to use the trademark for the specified services because it lacks the required license from Bank Negara Malaysia. This is because currently, only Wise Payments Malaysia is legally authorised to provide those services, not the appellant.

Our Decision

Revocation Under Section 46 Of The TMA 2019

[25] Section 46 of the TMA 2019 provides for the revocation of a trademark registration on the grounds of non-use. An application for revocation is made to the court, and if allowed, the court issues an order for the revocation of the mark from the Register of Trademark.

[26] In the present appeal, the appellant's application for partial revocation of the respondent's trademark from the Registry of Trademark is made pursuant to sub-ss. 46(1)(a) and 46(4) of the TMA 2019, which reads:

> 46. Revocation of registration by court as to non-use of trademark
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> (1) The registration of a trademark may be revoked by the Court on an application by an aggrieved person on any of the grounds as follows:
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> (a) where within a period of three years following the date of issuance of the notification of registration, the trademark has not been put to use in good faith in Malaysia, by the registered proprietor or with his consent, in relation to the goods or services for which the trademark is registered, and there are no proper reasons for non-use;
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> ...
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> (4) Where grounds for revocation exist in respect of only some of the goods or services for which the trademark is registered, revocation shall relate to those goods or services only.

[27] For the purpose of sub-s. 46(1)(a) of the TMA 2019, it is common ground that the appellant would have to establish two conditions, namely:

(i) that the appellant is an aggrieved person; and

(ii) that there has been non-use by the respondent of his registered trademark for a continuous period of three years following the issuance of the notification of registration.

Aggrieved Party

[28] The term "aggrieved person" was also used in ss. 45 and 46 of the Trademark 1976, the predecessor to ss. 46 and 47 of the TMA 2019, and this term was discussed by the Federal Court in *LB (Lian Bee) Confectionery Sdn Bhd v. QAF Ltd* [2012] 3 CLJ 661 where the Federal Court held that:

> [14] ... A "person aggrieved" need not be a person with any specific right. *A "person aggrieved" in this context may include someone with simply a bona fide intention to use a trade mark that is registered but which had not been used by the registered proprietor or any registered user* for a continuous period of not less than three years up to one month before the date of an application under s. 46(1) of the TMA to expunge ...
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> *Thus a "person aggrieved" may have no rights at all but merely a genuine intention to use a trade mark that is registered but which has not been used by the registered proprietor"*
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> (emphasis added)

[29] The Federal Court in the *LB (Lian Bee) Confectionery Sdn Bhd*'s case (*supra*) then quoted its earlier decision in *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749, at p. 759; [2009] 5 MLJ 741 where the Federal Court held that:

> [22] We understand that passage as laying down the principle that a **person aggrieved** is a person who has used his mark as a trademark – or **who has genuine and present intention to use his mark as a trademark** – in the course of a trade which is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the register.
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> (emphasis added)

[30] In *Agricultural And Processed Food Products Export Development Authority Of India (APEDA) & Ors v. Syarikat Faiza Sdn Bhd* [2011] 9 CLJ 394, Azahar Mohamed J (as His Lordship then was) in citing the Federal Court decision of *McLaren International Ltd* (*supra*) held at pp. 401 to 402:

> [11] ... The registration of the PONNI trade mark is blocking the use of the name and mark Ponni by others who have trading interests in Ponni rice. *The applicants' interests are and could further be negatively affected by the exclusive claim by the respondent over the PONNI trade mark ... a trade mark in Malaysia could and would affect their ability to distribute and/or otherwise trade in PONNI rice in Malaysia and elsewhere*. Hence, in my judgment, singly and collectively the applicants are persons aggrieved within the meaning of s. 45 of the Act.
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> (emphasis added)

[31] In *Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party)* [2015] 9 CLJ 125; [2015] 6 MLJ 465, the Federal Court held that an aggrieved person is someone who has used his mark as a trademark or who has a genuine and present intention to use his mark as a trademark in the course of a trade which is the same as or similar

to the trade of the owner of the mark that it wants to remove. In *Mesuma Sports*, the Federal Court also pronounced that its interest must be legal or lawful.

[32] The above principles have been reiterated by the Federal Court in the case of *Liwayway Marketing Corporation* (*supra*) where Balia Yusof Wahi FCJ held as follows:

> [10] In dealing with the issue of aggrievedness, learned counsel for Liwayway submitted that in order to satisfy the test as to whether the applicant falls within the definition of "a person aggrieved" in the said provision, Oishi Group must first show that it has either used before a mark that is identical with or similar to the registered mark sought to be expunged or at the very least had a genuine intention to use the mark in the near future.
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> [11] Our courts are replete with decisions on this issue. We will start with the case of *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749 wherein this court upon considering the judgment of Chan Sek Keong JC in *Re Arnold D Palmer* [1986] CLJU 11; [1986] 1 LNS 11; [1987] 2 MLJ 681 and the authorities cited therein, agreed that:
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> > A person aggrieved is a person who has used his mark as a trademark – or who has genuine and present intention to use his mark as a trademark – in the course of a trade which is the same or similar to trade of owner of the registered trade mark that the person wants to have removed from the register.
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> [12] McLaren International was referred to and reaffirmed in the case of *LB (Lian Bee) Confectionary Sdn Bhd v. QAF Ltd* [2012] 3 CLJ 661. At p. 671 of the report, this court had explained the following:
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> > A "person aggrieved" under s. 46(1) of the TMA need not be a person with any specific right. A "person aggrieved" in this context may include someone with simply a *bona fide* intention to use a trade mark that is registered but which has not been used by the registered proprietor or any registered user for a continuous period of not less than three years up to one month before the date of an application under s. 46(1)(b) of the TMA to expunge. On this point in the case of *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749, Abdul Aziz Mohamad FCJ in delivering the judgment of this court had this to say:
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> > > [21] *Re Arnold D Palmer* is an authority (out of several) that is heavily relied on by the respondent to deny that the appellants are a person aggrieved. In that case, the applicant sought the removal from the register of a trade mark on the ground of non-user. On whether the applicant was a person aggrieved, Chan Sek Keong JC, after considering the speeches of Lord Herschell and Lord Watson in the House or Lords in *Powell's Trade Mark* [1894] 11 RPC 4; [1984] AC 8, and the manner in which subsequent judges reacted to the opinions of the said

> Law Lords in *Lever Bros, Port Sunlight Ltd v. Sunniwite Products Ltd* [1949] 66 RPC 84, *Consort Trade Mark* [1980] RPC 160, and *Wells Fargo Trade Mark* [1977] RPC 503 concluded as follows: On the basis of these decisions, it is plain that the applicant will fail in this appeal unless he can show that he has used his trade mark in the course of a trade which is the same as or similar to that of the respondents or that he has a genuine and present intention to use the mark as a trademark. But the evidence shows none of these things, as the Registrar has found ...
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> [22] We understand that passage as lying down the principle that a person aggrieved is a person who has used his mark as a trademark - or who has a genuine and present intention to use his mark as a trademark - in the course of a trade which is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the register.

Thus a "person aggrieved" may have no rights at all but merely a genuine intention to use a trade mark that is registered but which has not been used by the registered proprietor.

[12] More recently, in the case of *Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party)* [2015] 9 CLJ 125; [2015] 6 MLJ 465, Azahar Mohamad FCJ delivering the judgment of this court reiterated:

> A person aggrieved is a person who has used his mark as a trademark or who has genuine and present intention to use his mark as a trademark in the course of a trade which is the same as or similar to the registered trademark that the person wants to have removed from the register. The person must be someone who has some element of legal interest, right or legitimate expectation in its own mark which is being substantially affected by the presence of the registered trademark. The interest and right must be legal or lawful.

In *Fazaruddin bin Ibrahim (b/s Perniagaan Fatama) v. Parkson Corporation Sdn Bhd* [1997] 2 CLJ 863; [1997] 2 AMR 1197, Abdul Malik Ishak J (later JCA) held that the phrase "person aggrieved" should be construed liberally construed and included any application whose own application for registration is obstructed by the opposing party. Put simply in other words, I find that the phrase applies to a party who has a legitimate business with genuine intention of using the mark but adversely curtailed by the prior registration of the trade mark by another party.

[33] From the above cases, we can conclude that an aggrieved person is one who has either used their mark as a trademark or has a genuine and immediate intention to do so in a trade that is identical or similar to the trade of the owner of the registered trademark that they seek to remove from the register. This person must also have a legal interest, right, or legitimate expectation in their own mark, and that his interest/rights are substantially impacted by the presence of the registered mark.

[34] We are of the considered opinion and we agree with the appellant that the appellant is an aggrieved person within the meaning of s. 46 of the TMA 2019, and therefore has necessary *locus standi* to make the application pursuant to sub-ss. 46(1)(a) and 46(4) of the TMA 2019.

[35] The evidence before the court clearly shows that the appellant's Wise marks (and previously its TransferWise marks) have been used in Malaysia and are currently used in Malaysia in respect of currency exchange and transfer services by its subsidiary Wise Payments Malaysia since February 2021. Wise Payment Malaysia is duly licensed to carry its business by Bank Negara Malaysia under the Money Services Business Act 2011.

[36] However, the respondent took the position that any use of the appellant's Wise Marks by Wise Payment Malaysia, the appellant's subsidiary, cannot be considered as use of the marks by the appellant in Malaysia, as they are different entities. Added to that, without a licence issued by Bank Negara Malaysia, the appellant is legally prohibited from providing services falling under Class 36, as governed by the Money Services Business Act 2011. Therefore, even if Wise Payments Malaysia is using or genuinely intends to use the Wise marks in Malaysia, such use or intention cannot confer the necessary *locus standi* on the appellant to initiate this revocation proceeding.

[37] Although the use of the appellant's Wise marks in Malaysia is carried out by its Malaysian subsidiary, we are of the considered opinion that the use of the said trademarks accrues to the appellant, being the owner of the appellant's Wise marks. Therefore, the permitted use of a mark through either a subsidiary or licensee, accrues to the proprietor of the mark and the proprietor of the mark is an aggrieved person within the ambit of s. 46, armed with the necessary *locus standi* to file the application to revoke a registered mark for non-use. (see *Appraisal Property Management Sdn Bhd & Ors v. Singham Sulaiman Sdn Bhd* [2023] 2 CLJ 206; *Colliers International Property Consultants Inc v. Colliers International Property Consultants Sdn Bhd* [2015] 1 LNS 252)

[38] Even though the above cases are not directly in respect of use for the purposes of establishing 'aggrieved person' under s. 46 of the TMA 2019, we agree with the appellant that the established principles therein apply equally to the issue of an aggrieved person under s. 46 of the TMA 2019.

[39] This is because the proprietor holds the rights to the mark, while the subsidiary or licensee does not own it and must stop using it if permission ends. If another registered trademark affects its use, it is the proprietor who is impacted.

[40] In the present appeal, it is the appellant, not its subsidiary Wise Payments Malaysia, that owns the Wise marks, as shown by its use in other countries and trademark filings in Malaysia. As such, the appellant has used

the Wise marks for currency exchange and transfer services in Malaysia, first through a third party in 2017 and then through its subsidiary, Wise Payment Malaysia, since 2019.

[41] Added to that, the fact that the license is granted to the Malaysian subsidiary for the commercial transactions by Bank Negara is not relevant to the issue of ownership of the appellant's Wise marks.

[42] In any event, we are also of the considered opinion that the appellant has a genuine and present intention to use the Wise Marks for its expanded services in Malaysia. When the application was filed, the appellant had a genuine and present intention to use the Wise marks for e-money accounts and multi-currency debit cards in Malaysia. Since December 2021, the Wise marks have been used for these services through its subsidiary, Wise Payments Malaysia Sdn Bhd.

[43] Apart from the use of its Wise marks by its subsidiary company, the fact that the appellant has applied to the Registrar of Trademark to register its trademarks clearly shows that the appellant has a genuine and present intention to use the Wise Marks for its expanded services in Malaysia. Added to that, between 2018 and February 2021, the appellant has filed several trademark applications in Malaysia for services like electronic money transfers, foreign currency trading, online banking, and bank cards, all using the word "Wise." However, these applications have faced objections.

[44] As such, we agree with the decision of the High Court in *Essity Hygiene And Health AB v. Praba's Vcare Health Clinic Privited Limited* [2019] 1 LNS 1124, where the plaintiff, a Swedish company, filed a non-use revocation action under s. 46 of the Trade Marks Act 1976. Although its Malaysian subsidiary was responsible for manufacturing, importing, and distributing the products in Malaysia, the court still considered the Swedish parent company to be an aggrieved party and allowed it to bring the case. The learned High Court Judge held at para. (25) as follows:

> [25] From the evidence adduced by the Plaintiff in its affidavits, I am satisfied that the *Plaintiff is a person aggrieved because the Plaintiff honestly has the genuine present intention to use the Mark in Malaysia. It is plain to me that the fact the Plaintiff made an application to the Registrar of Trade Marks to register the Mark as well as having already registered the Mark in other jurisdictions such as in Colombia and Mexico are sufficient to meet the threshold of a person aggrieved*. This shows the Plaintiff's desire to expand into Malaysia to trade in products using the Mark.
>
> (emphasis added)

[45] Further, we also agree with the appellant that it is not a mere busybody and clearly has a trading interest *vis-à-vis* the Wise marks. The appellant, having used the Wise marks in various jurisdictions and having expanded its services to Malaysia has a legal interest to use its Wise marks in Malaysia.

[46] Finally, given that both the Wise marks and the PBB Registered Wise mark comprise the word 'Wise', the presence of the PBB Registration on the Register of Trademarks may substantially affect the appellant.

[47] Therefore, we are of the considered opinion that the learned judge has committed an appealable error in his finding that the appellant is not an aggrieved person within the meaning of s. 46 of the TMA 2019. The learned judge has committed an error in his finding that the appellant is not an aggrieved party simply because it is the Malaysian subsidiary, Wise Payments Malaysia, that provides the services using the Wise marks, not the appellant. Additionally, the appellant cannot use the Wise marks as it lacks the required license from Bank Negara.

[48] In the present appeal, the appellant has clearly established that it has used the Wise marks through its subsidiary, Wise Payments Malaysia. Added to that, the appellant has shown its genuine intention to continue to use their Wise marks as a trademark. It is also not in dispute that both the appellant's trademark and the respondent's trademark are similar and in the same class 36 for registration purposes and that the appellant has applied to register its trademarks, which are currently pending approval.

Partial Revocation For Non-use

[49] The next issue is on the non-use of the registered mark for a continuous period of three years under sub-s. 46(1)(a) of the TMA 2019. Under this provision, the three-year period of non-use for the trademark in question is linked to the "notification of registration." This notification of registration is issued by the Registrar to the successful applicant or proprietor, pursuant sub-s. 36(2) of the TMA 2019. Added to that, under sub-s. 36(3), a certificate of registration is considered equivalent to the notification of registration issued under sub-s. 36(2).

[50] Therefore, for the purpose of sub-s. 46(1)(a) of the TMA 2019, the onus is on the appellant to establish *prima facie* evidence that the respondent Registered Mark had not been used in good faith in Malaysia for a period of three years from 9 January 2002 to 9 January 2005.

[51] Justice Ramly Ali (as His Lordship then was) in *Godrej Sara Lee Ltd v. Siah Teong Teck & Anor (No 2)* [2007] CLJU 230; [2007] 1 LNS 230; [2007] 7 MLJ 164, held that the party who applies for the revocation on ground of non-use the plaintiff has to prove at the outset a *prima facie* case of non-use. Once this is done, the burden falls upon the defendant as the registered proprietor to show evidence of use during the material period of time. Justice Ramly Ali held as follows:

> [19] Case law has suggested that all the applicant for rectifications has to prove at the outset is *prima facie* case of non-use. Once this is done, the burden falls upon the registered proprietor being the 1st respondent (in the present case) to show evidence of use during the material period of time. (*Trina Trade Mark* [1977] RPC 131).

[20] In the present case, a *prima facie* case has been made out. Independent investigations have been carried out by the applicant ...

[21] It is thus clear that a *prima facie* case has been established. It is thus up to the 1st respondent to refute this position. The question is whether the 1st respondent has in fact done this. For an answer to this, the affidavits in reply filed by the 1st respondent have to be considered.

[52] In *Lam Soon Edible Sdn Bhd v. Hup Seng Perusahaan Makanan (M) Sdn Bhd* [2010] 5 CLJ 975; [2010] 4 MLJ 702 Azahar Mohamed J (later CJ of Malaya) referred to *e-Toyo Global Stationery Sdn Bhd v. Toyo Ink Sdn Bhd & Anor* [2004] 7 CLJ 368; [2005] 1 MLJ 445 and held at p. 979 (CLJ); pp. 707 and 709 (MLJ) as follows:

[10] Next, it is the contention of the applicant that there has in fact been non-use by the respondent of the 'NATURELL' mark in good faith in relation to the goods for a continuous period of not less than three years up to 16 March 2009, *ie*, one month before institution of this proceeding. *In this regard, the onus is on the applicant to establish a prima facie case of non-use of the 'NATURELL' mark in Malaysia before the evidential burden would shift to the respondent to adduce evidence of such use* (see *NV Sumatra Tobacco Trading Co v Nanyang Brothers Tobacco Co Ltd* [2001] 1 SLR 197, *E-Toyo Global Stationery Sdn Bhd v. Toyo Ink Sdn Bhd & Ors; the Registrar of Trade Marks (Interested Party)* [2005] 1 MLJ 445; [2004] 7 CLJ 368).

(emphasis added)

[53] A passage from *Kerly's Law of Trade Marks and Trade Names,* 12th edn (p. 206) states that "where the applicants for rectification furnished no evidence as to the manner of trading under the respective marks, they were held not to have discharged the onus upon ...".

Prima Facie Non-use

[54] The appellant claims that the respondent has only used the PBB Registered Wise mark in Malaysia for children's savings accounts and hasn't used it for any other services since 9 January 2002. In other words, the mark was only used for children's savings accounts during the required three-year period after its registration on 9 January 2002.

[55] At the High Court, the appellant presented two investigation reports to show *prima facie* non-use of the mark. These reports, dated 3 November 2020 and 16 April 2021 respectively, were prepared by two private investigation firms, Bishop IP Investigations and Maxguard Security & Services Sdn Bhd.

[56] The first report, prepared by Bishop in November 2020, involved several investigations covering the period from 1997 to November 2020. These included:

(i) internet searches, including the respondent's website (www.pbebank.com) and its archived versions since 2004, as well as its social media accounts;

A (ii) online articles dating back to 1997; and

(iii) telephone interviews with the respondent's customer service agents.

[57] In summary, the Bishop report found no evidence of the PBB registered Wise mark being used for children's savings accounts or any other
B services. It only mentioned that the Wise Savings Account was introduced in 1997 and continued to be offered as of November 2020, using the WISE savings account name and logo for children's accounts.

[58] In April 2021, the appellant asked Maxguard Security to investigate the use of the PBB registered Wise mark in Malaysia. The findings were
C detailed in a report dated 16 April 2021 ("Maxguard report"). The investigator, as part of the Maxguard report, conducted checks including:

(i) reviewing the respondent's website, where the "WISE savings account" was found, offered only for children under 18. The "WISE savings
D account" name and logo were used for this service, but the PBB Registered Wise Mark wasn't found on the site for children's accounts or any other services;

(ii) internet searches confirmed that the "WISE savings account" name (but not the PBB registered Wise mark) was only used for children's
E accounts in Malaysia;

(iii) during a visit to the respondent's headquarters, the investigator received a brochure showing the "WISE savings account" and the PBB registered Wise mark, which only related to children's savings accounts;

(iv) an employee confirmed that the WISE savings account had been
F available for over ten years and that the PBB registered Wise mark was only used for children's accounts; and

(v) the employee also mentioned that children signing up for a WISE savings account receive a passbook, and those over 18 can apply for an
G ATM card. The employee had been with the respondent for more than ten years as a customer service officer.

[59] The findings in both the Bishop and Maxguard reports are consistent. The appellant had confirmed, through checks on the respondent's website (including archived versions since 2004), internet searches dating back to
H 1997, and inquiries with the respondent's staff, that the PBB registered Wise mark is only used for children's savings accounts and not for any other services.

[60] We are therefore of the considered opinion that the evidence presented by the appellant is strong enough to show, on a *prima facie* basis, that the
I respondent has not used the PBB Registered Wise Mark for any services, other than children's savings accounts, during the relevant statutory period.

Respondent's Evidence Of Use Of Trademark

[61] Since the appellant has establish a *prima facie* case of non-use of the respondent's trademark for any services, other than children's savings accounts, during the relevant statutory period, the burden then shifted to the respondent as the registered proprietor to show evidence of use during the material period of time.

[62] We are of the considered opinion that the respondent had failed to rebut the evidence and to establish use of the PBB registered Wise mark in respect of any of the registered services. The evidence adduced by the respondent discloses, if at all, only use of the PBB registered Wise mark in respect of 'children's savings accounts.

[63] In its affidavits, the respondent stated that "**the defendant has a genuine and present intention to use** the WISE mark in relation to some or all the services or to authorise or licence one or more of its subsidiaries to use the WISE mark in relation to some or all of the services included in the defendant's Registered Mark including insurance services, investment services, securities brokerage and stock brokerage, financing of loans, money exchange services and management services for loan related transactions". (emphasis added)

[64] We are of the considered opinion and we agree with the appellant that this statement amounts to admission by the respondent that it has not used the PBB registered Wise mark at least in relation to "insurance services, investment services, securities brokerage and stock brokerage, financing of loans, money exchange services and management services for loan related transactions".

[65] In fact, the learned judge has also made a finding that the evidence clearly show that the respondent's trademark was only used in the children savings account:

> [40] Secondly, the evidence before this Court – which is not disputed by the plaintiff – shows that the defendant's Trademark is in actual fact being actively used by the defendant. And it is used for the very intent and purpose of that Trademark – the Public Bank's children savings accounts ...

[66] In conclusion, we find that the evidence presented by the respondent shows use of the PBB registered Wise mark only for children's savings accounts, if at all. There is no evidence of its use for any other services, which aligns with the findings in the Bishop and Maxguard reports provided by the appellant.

A *Application Of Subsection 46(4)*

[67] While the learned High Court Judge acknowledged that sub-s. 46(4) permits partial revocation of a trademark registration, the judge determined that banking and finance services cannot be easily separated. The services listed for the PBB registered Wise mark are directly related to the services
B currently offered by the respondent and its future services.

[68] We are of the considered opinion and we agree with the appellant that under sub-s. 46(4) of the TMA 2019, the court has the authority to remove goods or services from a registered trademark if the trademark is only used
C for a narrower range of goods or services.

[69] Subsection 46(4) of the TMA 2019 provides that:

> Where grounds for revocation exist in respect of only some of the goods or services for which the trademark is registered, revocation shall relate to those goods or services only.

D **[70]** Whilst there are no reported Malaysian cases on this issue, sub-s. 46(4) of the TMA 2019 is *in pari materia* with the equivalent provisions in the United Kingdom and Singapore Trade Marks Act. Subsection 46(5) of the UK Trade Marks Act 1994 provides that:

E
> Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

[71] Subsection 22(6) of the Singapore Trade Marks Act provides:

> Where grounds for revocation exist in respect of only some of the goods
F or services for which the trade mark is registered, revocation shall relate to those goods or services only.

[72] Learned counsel for the appellant has referred to several cases in the UK and Singapore on the interpretation provisions which are *in pari materia* with our sub-s. 46(4) of the TMA 2019.

G **[73]** In *Mercury Communications Limited v Mercury Interactive (UK) Limited* [1995] FSR 22 (which was decided under the UK Trade Marks Act 1938), the plaintiff owned the trademark "MERCURY" for computers, electronic data processing instruments, and computer programs in Class 9. The plaintiff filed an infringement lawsuit against the defendant, who sold computer
H programs for analysing, testing, and debugging software under marks that included the word "MERCURY." The defendant sought to invalidate the registration, on *inter alia*, the ground of non-use. The plaintiff moved for summary judgment. In dealing with the same, Laddie J held:

I
> ... In any event, whether that was accepted or not, in my view, there is a strong argument that a registration of a mark simply for "computer software" will normally be too wide. In my view, the defining characteristic of a piece of computer software is not the medium on which

it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs ... *In my view, it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does, he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods ...*

(emphasis added)

[74] In *Minerva Trade Mark* [2000] FSR 27, the applicant applied to revoke the registration of the mark 'Minerva' in Class 16 which was registered for "paper and paper articles, cardboard and cardboard articles; printed matter; stationery; artists materials (other than colours or varnish); drawing instruments; office requisites other than furniture; ordinary playing cards; all included in Class 16 on, *inter alia*, the ground of non-use. Jacob J found that there has been use in relation to printed stationery but not in relation to print literary matter. In view thereof, Jacob J was of the view that he could cut down the registered specification. Jacob J held:

I am quite satisfied that I do have the power to rectify in that manner ... I have no doubt that what Laddie J assumed was right and, in this respect, I differ from Neuberger J. *The problem is that some of the language for specifications of goods is apt to be extremely wide. Indeed, "printed matter" in this case is extremely wide*. I think it is inevitable that at times one would have to "dig deeper" ... Wide words can cover what are commercially quite different sorts of articles. *So, if one were to show use for just one of that sort, it would be commercially nonsense to maintain the registration for all goods caused by the wide words*.

That is not to say the court will cut the registration right down to things like red tea caddies. *But if non-use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the registration*.

... My decision was that the registration, so far as it covered printed matter other than stationery was invalid.

(emphasis added)

[75] In the *Minerva* case, the trademark was only used for printed stationery. The court revoked the trademark for all other printed materials except for stationery.

[76] The position in the above UK cases has been adopted in Singapore in the case of *Weir Warman Ltd v. Research & Development Pty Ltd* [2007] SGHC 59. In *Weir Warman Ltd* (*supra*), the High Court held as follows:

Partial Revocation

111. I must observe, however that as within Class 7, the defendant is only able to adduce evidence of use in relation to pumps and pump parts. Class 7 involve, however, a wider range of goods, including milling equipment

A and valves (see [2(a)] above), for which the defendant has not shown any use of the "Warman" mark. Section 22(6) of the TMA permits, indeed mandates, partial revocation of a registered trade mark in these circumstances:

> Where grounds for revocation exist and respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

112. The approach in the UK towards partial revocation is that it is open to the court (or Registrar) to require the specification of goods or services to be re-written in order to achieve the required degree of revocation such that the court may "dig deeper" into certain wider specification and insert words of limitation into the specification (see *ie*, *MINERVA Trade Mark* [2000] FSR 734; *Decon Laboratories Limited v. Fred Baker Scientific Ltd* [2001] RPC 293; *Thomson Holidays Ltd v. Norwegian Cruise Line Ltd* [2003] RPC 586). Locally, in *Bluestar Exchange (Singapore) Pte Ltd v. Teoh Keng Long* [2003] 4 SLR (R) 92 ("Bluestar"), Woo Bih Li J explained that the task of the court in partial revocation was to limit the specification so that it reflected the circumstances of the particular trade and the way the public would perceived its use.

113. *On the facts of the present case, I find that there should be revocation of the defendant's registration of the "Warman" mark in Class 7 with respect to milling equipment and valves.* I do not, however find it necessary to insert any words of limitation to the remaining specification namely, pumps and pump parts, in order to further confine the defendant's registration of the "Warman" mark to the particular types of pump parts which the defendant was able to adduce evidence of use for, as suggested by the plaintiff. In *Bluestar* ([112] *supra*), Woo J quite correctly rejected the applicant's argument to confine the respondent's use of the trade mark in the category "knitwear" to the specific categories of clothes for which the mark had in fact been used. He explained at paragraph [60]:

> Having taken into account that the respondents had use the [registered trade mark] for various kinds of clothing which could also be described as knitwear, I was of the view that it is not in the interest of the public or the trade to try and narrow the description of the clothing in the respondents' classification further to those specific categories for which [the registered trade mark] was in fact used. To do so would result in confusion and invite litigation.

I take a similar view of the present case. *To narrow the specification of "pump parts" into specific types of pumps for which the "Warman" mark was in fact used by the defendant would be unnecessarily confusing and restrictive as well as not in the interest of the public or the trade.*

(emphasis added)

[77] Applying the above principles, we are of the considered opinion that the learned judge has erred in fact and in law when he held that the services related to banking and finance could not be easily severed and compartmentalised, that the services for which the PBB registered Wise mark was registered were directly relevant to the services provided by the respondent and for future services.

[78] Since it has been clearly established that the PBB registered Wise mark is only used for "children's savings accounts", we are of the considered opinion that the learned High Court Judge should have partially revoked the PBB Registration, limiting it to "banking" and "financial" services only, as 'children savings account' falls within these two services. On this, we agree with VK Rajah JA's judgment in the Singapore High Court case of *Weir Warman Ltd* (*supra*) in para. 42:

> 42. Finally, the register is also meant to notify rival traders dealing in similar products of the rights over particular trademarks possessed by the registered proprietor. As such, it is also important that these registered marks be in actual use or be *bona fide* intended to be used by the registered proprietors; any contrary approach would result in unjust monopolies where devious registered proprietors could prevent the use of a mark by others despite not having any intention to use it, simply by reason of prior registration. Indeed, such "squatting" situations are addressed by most modern trade mark registration statutes, which require that the registrant has at least a *bona fide* intention to use a mark before registering it. ...

[79] On the facts here, the PBB registered Wise mark is registered in respect of the following specification of services:

> "banking, financial, insurance and investment services; real estate; securities brokerage; stock brokerage; computerised financial services; issuing letters of credit and travellers cheques; financing of loans; safe deposit and surety services; issuing statements of accounts; mortgage and purchase financing; money exchange services; automatic cash dispensing services; electronic funds transfer and automated payment services; credit and cash card services; trustee services, commodities and futures brokerage, management services for loan related transactions and financial planning services; all included in class 36"

[80] There is clearly no evidence of use of the PBB registered Wise mark, as a trademark, in respect of the following:

> "insurance and investment services; real estate; securities brokerage; stock brokerage; computerised financial services; issuing letters of credit and travellers cheques; financing of loans; safe deposit and surety services; issuing statements of accounts; mortgage and purchase financing; money exchange services; automatic cash dispensing services; electronic funds transfer and automated payment services; credit and cash card services; trustee services, commodities and futures brokerage, management services for loan related transactions and financial planning services; all included in class 36"

[81] Therefore, the aforesaid unused services ought to be removed by deleting the said words from the Registered Services.

[82] However, learned counsel for the appellant submitted further that the terms "banking" and "financial" are broad and encompass a wide variety of services. However, the respondent's use of the PBB Registered Wise Mark is limited to a specific, narrow service namely, children's savings accounts. The appellant submitted that the specification should be narrowed further, removing other categories within "banking" and "financial" services due to non-use, leaving only "children's savings accounts." This would partially revoke the PBB registration for non-use regarding other banking and financial services, and the registered mark will only be for "children's savings accounts."

[83] However, we are of the considered opinion that to remove other categories within "banking" and "financial" services due to non-use, leaving only "children's savings accounts" would be unnecessarily confusing and restrictive as well as not in the interest of the public or the trade. (see *Weir Warman Ltd*)

Conclusion

[84] For the reasons enumerated above, we find merit in the appeal and the decision of the learned judge is set aside. We make an order in terms of the alternative prayer (2), that the specifications of services for which the defendant's trademark is registered is to be limited to "banking" and "financial" services. Consequential prayer (3) of the originating summons is also allowed.